REMARKS

Claims 1-7, 10-21, 24-36 and 39-62 are pending in the application.

Claims 1, 2, 4-7, 11, 15, 16, 18-21, 25, 29-31, 33-36, 40, 44, 45, 47-49 and 51 have been rejected.

Claims 3, 10, 12-14, 17, 24, 26-28, 32, 39, 41-43, 46, 50 and 52-62 have been objected to.

Applicant acknowledges the indicated allowability of Claims 3, 10, 12-14, 17, 24, 26-28, 32, 39, 41-43, 46, 50 and 52-62, if amended to remove dependencies upon rejected base claims. While Applicant does not at this time choose to amend these claims to remove the indicated dependencies, Applicant reserves the right to do so in a subsequent response, if necessary.

Rejection of Claims under 35 U.S.C. § 103

Claims 1, 4-7, 11, 15, 18-21, 25, 29, 30, 33-36, 40, 44, 47-49 and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,122,281 issued to Donovan *et al.* ("Donovan") in view of U.S. Patent Applicant Publication 2001/0029546 A1 naming Motoyama as an inventor ("Motoyama"). Applicant respectfully traverses this rejection.

In order for a claim to be rendered invalid under 35 U.S.C. § 103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. § 103(a). This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references

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themselves or in the knowledge of the art; and (3) there must be a reasonable expectation of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Independent Claims 1, 15, 29, 30 and 44: Each of independent Claims 1, 15, 29, 30 and 44 contain limitations substantially similar to:

> transmitting data in a transport overhead field to at least one network element, the data providing a source identifier and a destination identifier; and
>
> processing the data in the transport overhead field to provide virtual path end-to-end services, wherein said processing is performed by a route processor.

See, e.g., Claim 1. Neither Donovan nor Motoyama, alone or in combination, teach both of these limitations.

The Office Action admits that Donovan does not disclose a source identifier and a destination identifier as data in a transport overhead field. Since Donovan does not disclose the claimed source and destination data in the transport overhead field, Donovan cannot disclose processing that data to provide virtual path end-to-end services. The Office Action cites to Donovan 6:10-22 for support of such disclosure. But the cited text supports Applicant's position that Donovan does not disclose this claim limitation because the overhead added to a LAN packet being transported across a SONET connection is only that overhead required by SONET. Such standard SONET overhead does not contain data that can be used to provide virtual path end-to-end services. (In fact, the present Application is directed, in part, at overcoming this deficiency.) Further, Applicant has found no disclosure within Donovan for providing end-to-end services

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such as those disclosed and claimed in the present Application. Nor has Applicant found

any disclosure within Donovan of a route processor that would perform such processing.

As stated above, the Office Action admits that Donovan does not disclose a

source or destination identifier in a transport overhead field. To overcome this deficiency

in disclosure, the Office Action suggests that Motoyama Figs. 11A, 11B & ¶¶ [0093]-

[0096] provide the needed disclosure of those items in a transport overhead field. While

Motoyama does disclose such fields in a transport overhead field of a modified SONET

frame, the Office Action provides no explanation of why such a combination of the

Motoyama with Donovan would be successful or a sufficient explanation of why a person

of ordinary skill in the art would be motivated to perform such a combination.

Both Donovan and Motoyama purport to disclose mechanisms for transporting

LAN data on a SONET network without encapsulating the LAN data in an ATM cell.

Both Donovan and Motoyama disclose LAN/SONET interfaces to perform the disclosed

tasks. But the disclosed mechanisms are mutually incompatible and therefore do not

suggest that a combination would meet with success.

Donovan provides disclosure of a SONET framer/deframer that uses "raw data

capability" for framing a LAN data packet. "The 'raw data' capability, also referred to as

'native frame format' capability, means that data can be transmitted across the SONET

network without adding additional overhead to the data other than the overhead which is

required by SONET." Donovan 6:10-14. As illustrated in Donovan Fig. 9, a LAN

packet is packed into a SONET SPE and the required SONET overhead is added to create

a SONET frame. The frame is transmitted over the network and then the transport

overhead is removed and the LAN packet is unpacked then sent onto a destination LAN. No other processing of the SONET frame is disclosed. *See* Donovan 6:39-67 & Fig. 9.

Motoyama also provides framing of a LAN packet into a SONET frame. But rather than using a "raw data" frame (a frame containing overhead that is only that required by SONET), Motoyama discloses the use of a modified SONET frame that includes a destination node and a source node address. *See* Motoyama Fig. 11 & [0093] ("DN and SN at the overhead of the SONET/SDH system side packet are node addresses which indicate the transmission destination and the transmission source nodes respectively."). Motoyama provides packet switching in a LAN interface that makes use of the destination and source information to determine whether a SONET frame has reached a destination node in a SONET ring. *See* Motoyama [0133]-[0141].

As disclosed, the Motoyama LAN interface cannot use the "raw data" SONET frame provided by Donovan. Motoyama requires the additional source and destination information found in the modified SONET overhead to determine whether a SONET frame has reached its destination. Without that source and destination information, Motoyama could not properly deliver encapsulated LAN data to its destination.

It is not clear whether Donovan's LAN interface could properly function using a packet formatted as disclosed in Motoyama. But Donovan teaches away from inserting any additional information in the SONET frame overhead beyond that "required by SONET." *See* Donovan 6:10-14. Thus, a person of ordinary skill in the art would not be motivated to combine the references in light of this contrary teaching.

The Office Action suggests that one would be motivated to combine Motoyama with Donovan "to identify the destination node and correlate data between the node

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numbers other than the local node and LAN addresses, but also the association with the ports." While Motoyama makes this statement (Motoyama [0096]), this does not provide a motivation to combine the teachings of Motoyama with Donovan, especially in light of the contrary teaching found in Donovan discussed above.

Applicant therefore respectfully submits that the Office Action has not satisfied the burden of factually supporting the alleged motivation to combine the two references. The Examiner's duty may not be satisfied by engaging impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the references.

> The reason, suggestion, or motivation to combine may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, "leading inventors to look to references relating to possible solutions to that problem."

Ruiz v. A.B. Chance Co., 234 F.3d 654, 665 (Fed. Cir. 2000).

The Office Action presents nothing more than a broad statements related to the motivation of a person of ordinary skill from one of the references while the other reference teaches away from such a combination; Applicant respectfully submits that this is insufficient to support a finding of obviousness. The Office Action does not establish that the references which are combined are of special interest or importance in the field. Nor does the Office Action present any evidence from within those references themselves of a problem to be solved that corresponds to the problem solved by the present Application. At best the problem addressed by the two references relates to maximizing bandwidth for LAN data transmission through a SONET network, solved in two different

ways by the two references. The end-to-end provisioning claimed by the present Application is not addressed by either cited reference.

Dependent Claims 5, 6, 19, 20, 34, 35, 48 and 49: The Office Action suggests that Motoyama and Donovan disclose the claimed virtual path end-to-end services. Applicant respectfully submits that the particular parts of the cited references that the Examiner has relied upon have not been designated as nearly as practicable, and the pertinence of each reference has not been clearly explained, both as required by 37 C.F.R. § 1.104(c)(2). *See also* MPEP § 706.02(j). Given this lack of specificity, Applicant is unable to respond to this rejection.
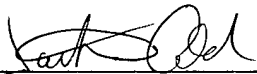
Dependent Claims 11, 25, 40 and 51: Applicants note that the Office Action reiterates the discussion presented for the independent claims related to inclusion of source and destination information in a modified SONET overhead field. In response, Applicants incorporate the discussion presented above with regard to the independent claims.

For these reasons, Applicant respectfully submits that the Office Action fails to present a *prima facie* case of obviousness of Claims 1, 15, 29, 30 and 44, and all claims dependent upon them, and that they are in condition for allowance. Applicant therefore requests the Examiner's reconsideration of the rejections to those claims.

CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5090.

Respectfully submitted,
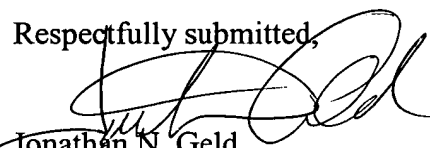
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